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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/627,688 | 07/28/2003 | Hideki Kato | 2018-756 | 4616 |

23117 7590 09/11/2006

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| EXAMINER |
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DRODGE, JOSEPH W

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| ART UNIT | PAPER NUMBER |
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1723

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/627,688 | Applicant(s) KATO ET AL. | |
| | Examiner Joseph W. Drodge | Art Unit 1723 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,20-22 and 29-47 is/are allowed.
- 6) ☒ Claim(s) 1-10,12-19 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1723

Claims 1,6 and 25-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification fails to support the recitations in each of claims 1 and 25-27 of the suction filter being disposed independently of the fuel filter AND the recitation in claim 6 of the check valve being capable of closing from an downstream side to an upstream side thereof. ***Thus, each of these newly rectited limitations in claims 1,6,25,26 and 27 constitutes NEW MATTER.***

Claims 1,6 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The meaning and scope of "the fuel filter being "disposed independently of the suction filter" in each of claims 1 and 25-27 is unclear. It is unclear if this is referring to the filters being contained in separate housings or simply to the filters being distinct and separate elements.

In claim 6, meaning of "capable of closing from a downstream side to an upstream side" is unclear, since no movable or biased valve element within the check valve is claimed.

ALLOWABLE SUBJECT MATTER

Claims 1,6 and 25-27, and claims dependent therefrom, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action.

Claims 1 and 25-27 would respectively be deemed to distinguish if amended to delete the phrase concerning independent disposition of fuel filter from suction filter.

Claim 6 would distinguish if amended by deleting the phrase concerning the check valve closing from downstream side to upstream side.

Independent claims 1 and 25-27 now distinguish in view of combination of limitations concerning there being both a suction filter upstream or a fuel pump and a fuel filter downstream of such fuel pump in combination with recitation of a pressure regulator which includes a regulator inlet for receiving fuel filtered by the fuel filter and which is disposed **radially** outside of the outer circumference of the filter casing.

Independent claim 6 now distinguishes in view of recitation of the fuel inlet of the fuel filter being accommodated within the inner circumference of the discharge portion of the fuel pump, a check valve being accommodated in an inner surface of the fuel inlet and such check valve being disposed on an upstream side of the fuel filter.

Independent claims 11,20-22,29 and 38 remain distinguished over all of the prior art as indicated in the previous Office Action.

Claims 11 and 38 respectively distinguish in view of recitation of pressure regulator being in the through hole of the fuel outlet so that it covers one open end thereof. Such configuration non-obviously gives a more compact arrangement.

Claims 20-22 respectively distinguish in view of limitations pertaining to filter casing having inner and outer cylinder with accommodation chamber therebetween accommodating fuel filter, such accommodation chamber facilitating convenient replacement of the fuel filter.

Claim 29 and claims dependent therefrom now are distinguished over the prior art of record in view of recitation of the suction filter not only overlapping the pressure regulator in the range of the center axial direction of the fuel pump, but also facing the pressure regulator in a radial direction of the fuel pump.

Applicant's arguments with respect to claims 1,6 and 25-27 and claims dependent therefrom have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1723

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1723


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

September 5, 2006


JOSEPH DRODGE
PRIMARY EXAMINER